

REMARKS

Claims 1, 3-23, 25-36, 38-46, 48-54, 56-71, and 73-96 are now pending and stand rejected. By this amendment, independent claims 1, 67, and 86, and dependent claims 6, 27, 40, 50, 75, and 92 are amended and claims 4, 73, and 90 are canceled, without prejudice. In view of the above amendments to the claims and the arguments below, Applicants respectfully request the Examiner to reconsider all the outstanding rejections and to withdraw them.

35 U.S.C. § 103 Rejections

In paragraph 6 of the office action, the Examiner has variously rejected the claims 1, 3, 7-19, 23, 25, 29-30, 32-33, 35, 38, 41-44, 46, 48, 51, 53, 56-59, 67-69, 71, 78-80, 86, 88-89, and 93-94 under 35 U.S.C. §103(a) as being unpatentable over a primary reference, Janakiraman et al. (U.S. Patent Application Publication No. 2002/0124020), in view of Nelson et al. (U.S. Patent No. 6,498,897). Applicants respectfully traverse that it would have been obvious to combine the references as the Examiner suggests and urges the Examiner to reconsider the rejections in view of the following reasoning set forth below.

For rejections under 35 U.S.C. Section 103, the establishment of a *prima facie* case of obviousness requires that all the claim limitations must be taught or suggested by the prior art. MPEP § 2143.03 The establishment of a *prima facie* case of obviousness requires that the claimed combination cannot change the principle of operation of the primary reference or render the reference inoperable for its intended purpose. MPEP § 2143.03

With respect to claims 1, 23, 35, 46, 53, 67 and 86, the Examiner simply states that Janakiraman teaches all the claimed limitations and is silent on “sending a list of supported formats to a proxy server.” The Examiner suggests curing this deficiency by introducing Nelson, for its teaching in a wireless communication method, of “sending a list of supported formats [col.4, lns.23-26 i.e. MPEG-1, MPEG-2, MPEG-4, H.263, Realvideo, and other packetized forms of digital media] to a proxy server [item 44 of fig.51 [figs.2-41].” Moreover, the Examiner indicates the following:

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Janakiraman in view of

Nelson by sending a list of supported formats to a proxy server because this feature enables to select the appropriate format and applications for playback based upon the specific characteristics [Nelson, col.2, lns.46-52]. It is for this reason that one of ordinary skill in the art at the time of the invention would have been motivated to modify Janakiraman in view of Nelson in order to properly initialize the decoder for the media format [Nelson, col.1, lns.24-25].

Claims 1, 67, and 86 now recite the limitation of “automatically updating the list of supported formats, which is not met by either Janakiraman nor Nelson. Both references are silent at least on this limitation, therefore do not meet the claims. With respect to this limitation, in paragraph 21 of the office action, the Examiner asserts yet another reference, Adachi, indicating that it discloses automatically updating the list of supported formats to reflect the changes in applications included in the electronic device [see abstract and fig.5]. Therefore, the Examiner believes that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify both Janakiraman and Nelson, further in view of Adachi by automatically updating the list of supported formats because this feature allows efficient updating of a number of data modules by sending only one location registration request to the network [Adachi, col.8, lns.52-57]. The Examiner asserts that it is for this reason that one of ordinary skill in the art at the time of the invention would have been motivated to modify both Janakiraman and Nelson in view of Adachi in order to receive the copy of the most recent data and the version number from the server system and updates that are installed [Adachi, col.1, lns.65-67]. Respectfully, any updating of “data modules” that occurs is triggered by some action taken by the user.

In this regard, Applicants respectfully submit that obviousness is to be determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. See 35 U.S.C. § 103(a). The legal construct also presumes that all prior art references in the field of the invention

are available to this hypothetical skilled artisan. *In re Carlson*, 983 F.2d 1032, 1038, 25 USPQ 2d 1207, 1211 (Fed. Cir. 1993).

An examiner may often find every element of a claimed invention in the prior art. "Virtually all [inventions] are combinations of old elements." *Environmental Designs, Ltd. V. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed.Cir. 1983); see also *Richel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed.Cir. 1983). If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 U.S.P.Q.2d 1551, 1554 (Fed.Cir.1996). In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.

All the remaining claims, depend either on claim 1, 67, or 86 and are dependent at least for the same reasons that these claims are distinct.

Conclusion

Applicants respectfully requests the Examiner to consider the legal reasoning, amendments and arguments urged here and to allow this application.

Respectfully submitted,

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